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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,761	03/22/2004	Tanna Marie Richardson	SLA1564	1251

7590 05/01/2008
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EXAMINER

SHAN, APRIL YING

ART UNIT	PAPER NUMBER
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2135

MAIL DATE	DELIVERY MODE
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05/01/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/805,761	Applicant(s) RICHARDSON, TANNA MARIE	
	Examiner APRIL Y. SHAN	Art Unit 2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,7,8,10,12,13 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 7, 8, 10, 12, 13 and 16-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The Applicant's amendment, filed 08 February 2008, has been received, entered into the record, and respectfully and carefully considered.
2. As a result of the amendment, claim 1 has been amended. Claims 1, 3-4, 7-8, 10, 12-13 and 16-18 are now presented for examination.
3. Any objection not repeated below for record are withdrawn due to Applicant's amendment to the claims and cancellations of the claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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6. Claims 1, 3-4, 7-8, 10, 12-13 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGraw (U.S. Patent No. 6,542,261) in view of Chan et al. (U.S. Patent No. 6,378,070)

As per **claims 1 and 10**, McGraw discloses a method/system, comprising:

at a source, scanning a document ("The document to be sent via secure FAX in accordance with the present invention is scanned by the sender's FAX machine or other scanning device" - e.g. col. 2, lines 53-55);

accepting a password ("In general, the sender of the FAX enters a "code" into either a FAX machine's control panel or an associated computer which is running a secure FAX software package. The code is known by the intended recipient of the FAX..." - e.g. col. 2, lines 48-53.

Please note a code corresponds to Applicant's password);

encrypting the scanned document creating an encrypted document ("The scanned data is encrypted via one of a variety of known encryption techniques...." - e.g. col. 2, lines 55-58); and,

transmitting a file including a header with an unencrypted identification of the encrypted document, and the encrypted document (e.g. col. 3, lines 54-58, "An unencoded header containing, at least, information describing who the intended recipient of the FAX document and who the FAX document is from, along with other pertinent information is included" and in col. 3, lines 6-11, "The printed or viewed received FAX will have the unencrypted header at the top of the page so that the receiving party (who may not be the intended recipient) will know to whom the received secure FAX document should be given to. For example a hotel's business center would need to know which guest the secure FAX should be delivered to. and col. 1, line 67 – col. 2, line 10, col. 2, line 59 - col. 3, line 18 and col. 6, lines 27-36), from the source to a network-connected printer ("The secure FAX

data (secure bit map and header) is sent as a normal FAX to a communication system 16. The communication system can be ...internet system or any communication system that can or is adopted to carry out a FAX transmission" - e.g. col. 3, lines 58-64, "The CPU 64, memory 68 and scanner may all be contained in a multifunction printer/scanner/FAX machine" – e.g. col. 4, lines 64-65, fig. 2 and FAX machine 30 is connected to communication system 16 in fig. 1. Please note internet system is the worldwide, publicly accessible network and therefore, FAX machine 30 is a network-connected printer)

at the printer, accepting the file from the source (e.g. col. 6, lines 34-53);

storing the encrypted document in printer memory until a user enters an access code (e.g. col. 5, lines 21-25, col. 5, lines 36-42);

accepting the access code from the user at a printer local interface (e.g. col. 6, lines 53-56);

in response to a matching the access code to the password, decrypting the encrypted document ; and printing the decrypted document (e.g. col. 6, lines 57-62).

McGraw further discloses in col. 6, lines 53-55 "In step S26, the user is queried for the code (decryption code) that must be used to decrypt the encrypted bit map/bit stream into a human readable document". Inherently, there must be some kinds of comparison step to verify the code is the correct code to decrypt the document.

Chan et al. discloses the file includes a password and comparing the access code to the password in the file ("...to transmit to the print server the document accompanied by a first identifier for the intended recipient...comparing the second identifier with the stored first identifier..." - e.g. col. 2, lines 15-34). It would have been obvious to a person with ordinary skill in

the art at the time of the invention to combine Chan et al.'s well known features of file includes a password and comparing the access code to the password in the file with McGraw in order to “increase the security of remote printing” (Chan et al. col. 2, lines 7-8).

As per **claims 3 and 12**, McGraw – Chan et al. discloses a method/system as applied above in claims 1 and 10. Chan et al. further discloses wherein accepting a password includes accepting a password selected from the group including a PIN number, an alphanumeric code, biometric data, Smart card, magnetic stripe card, and proximity badge (e.g. abstract and col. 2, lines 48-53).

As per **claims 4 and 13**, McGraw – Chan et al. discloses a method/system as applied above in claims 1 and 10. McGraw further discloses wherein encrypting the document includes: at the source, deriving an encryption key from the password; and,

using the encryption key to encrypt the document (e.g. col. 1, lines 64-67 and col. 2, lines 47 - 58).

As per **claims 7 and 16**, McGraw – Chan et al. discloses a method/system as applied above in claims 1 and 10. Chan et al. further discloses comprising: at the source, hashing the password (“...This can be achieved using a message digest function such as the **Secure Hash Algorithm** (SHA-1)...” – e.g. col. 6, lines 15-28); at the printer, entering the access code and, wherein comparing the access code to the password includes comparing (e.g. col. 2, lines 15-34).

As per **claims 8 and 17**, McGraw – Chan et al. discloses a method/system as applied above in claims 1 and 16. McGraw further discloses wherein decrypting the document includes:

regenerating the encryption key from the access code; and,

using the encryption key to decrypt the encrypted document (e.g. col. 6, lines 53 -56).

As per **claim 18**, McGraw – Chan et al. discloses a system as applied above in claim 11. Chan et al. further discloses wherein the printer user interface accepts an access code selected from the group including a PIN number, an alphanumeric code, biometric data, Smart card, magnetic stripe card, and proximity badge (e.g. abstract and col. 2, lines 48-53).

Response to Arguments

7. Applicant's arguments filed 8 February 2008 have been fully considered but they are not persuasive.

8. The Applicant's arguments summarized as below:

a. The Applicant argues on page 9 of the remark, "neither McGraw nor Chan disclose the transmission of a document with an unencrypted identification of encrypted document".

b. The Applicant argues on page 9 of the remark, "neither McGraw nor Chan disclose the transmission of a password or the transmission of a password with an encrypted document".

c. The Applicant argues on page 10 of the remark, "neither reference discloses the transmission of password in a file header".

d. The Applicant argues on page 9 of the remark, "the person of ordinary skill in the art would be unlikely to combine the McGraw and Chan reference".

e. The Applicant argues on page 10 of the remark, the dependent claims 3, 4, 7-8, 12-13 and 16-18 are allowable due to dependency on claims 1 and 10.

In response to argument 'a', the examiner respectfully disagrees. The examiner begins by considering the scope and meaning of the terms "a file including header with an unencrypted identification of the encrypted document", which must be given their broadest reasonable interpretation consistent with Applicant's disclosure, as explained in *In re Morris*, 127 F. 3d 1048,

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1054 (Fed. Cir. 1997) and see also *In re Zletz*, 893 F. 2d 319, 321 (Fed. Cir. 1989), in which stating the claims must be interpreted as "broadly as their terms reasonably allow".

Applicant's specification states the following:

[0026] For example, the scanner 202 may transmit a file with an **unencrypted header that includes an identification** of the scanned document.

The examiner further states, "the ordinary meaning of a claim term is its meaning to the ordinary artisan after reading the entire patent." *Philips V. AWH Corp.*, 415 F. 3d 1303, 1321 (Fed. Cir. 2005).

Upon reviewing Applicant's Specification, the examiner fails to find any definition of the terms "a file including header with an unencrypted identification of the encrypted document" – that is different from the ordinary meaning. The examiner finds the ordinary meaning of the term "a file including header with an unencrypted **identification** of the encrypted document" is best found in the dictionary. The examiner notes that the definition most suitable for "identification" is "anything by which a thing can be identified." Consequently, the examiner construes "a file including header with an unencrypted **identification** of the encrypted document" is anything in the header (i.e. unencrypted information) by which the encrypted document can be identified.

McGraw discloses in col. 3, lines 54-58, "An unencoded header containing, at least, information describing who the intended recipient of the FAX document and who the FAX document is from, along with other pertinent information is included" and in col. 3, lines 6-11, "The printed or viewed received FAX will have the unencrypted header at the top of the page so that the receiving party (who may not be the intended recipient) will know to whom the received secure FAX document

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should be given to. For example a hotel's business center would need to know which guest the secure FAX should be delivered to.”

Clearly, McGraw's unencrypted header information describing who the intended recipient/sender of the document is an identification of the document since it helps to identify who/where this secure document should be delivered to.

In response to argument 'b', the examiner respectfully traverses. Chan discloses in col. 2, lines 15-19, "...to transmit to the print server **the document accompanied by a first identifier**" and further in col. 2, lines 40-43, for security purposes, the document is preferably **encrypted**. Please note a first identifier corresponds to Applicant's password and is transmitted with an encrypted document. Therefore, Chan met the claimed limitation of transmission of a password or the transmission of a password with an encrypted document.

In response to argument 'c', the examiner respectfully disagrees. The examiner respectfully invites the Applicant to read instant application's independent claim 1, "transmitting a file including a header with an unencrypted identification of the encrypted document, the password, and the encrypted document, from the source to a network-connected printer". The examiner's interpretation is the transmitting file has three parts, a header with an unencrypted identification of the encrypted document, the password and the encrypted document and it is a reasonable interpretation. From the language of this claim limitation, the password is part of the transmitting file, but not necessarily as argued by the Applicant that the password must reside in a file header. For the sake of the argument, even if the password is part of the unencrypted header as argued by the Applicant, it defeats the purpose of the instant application of document security since the password is unencrypted in the header, then everyone at the receiving side can spot the password and access the document.

In response to argument 'd', the examiner respectfully traverses. First, the examiner again invites the Applicant to read instant applications independent claim 1. Claim 1 recites,

" A method for scan to confidential print job communications, the method comprising:

at a source,

scanning a document; accepting a password;

encrypting the scanned document~ creating an encrypted document;

transmitting a file including a header with an unencrypted identification of the encrypted document, the password, and the encrypted document, from the source to a network-connected printer;

at the printer,

accepting the file from the source;

storing the encrypted document in printer memory until a user enters an access code;

accepting the access code from the user at a printer local interface;

comparing the access code to the password in the file;

in response to a matching the access code to the password, decrypting the encrypted document; and, printing the decrypted document."

From claim 1, it is clear there are both a sending side at the source and a receiving side at the printer. The examiner respectfully invites the Applicant to read above citations by the examiner from McGraw and Chan et al. reference, it is undisputed that both McGraw and Chan et al. reference teach a sending side at the source and receiving side at the printer and therefore, the Applicant's argument on page 9 of McGraw only teaches security procedure at the receiving side and Chan et al. only teaches security at the sending side is incorrect since in

McGraw, the fax is encrypted at the sending side and in Chan et al., the document has to be decrypted and compare the recipient's second identifier to the first identifier. For the sake of the argument, even if McGraw only teaches security at the receiving side and Chan et al. only teaches security at the sending side, the Applicant is respectfully reminded that One cannot show nonobviousness by attacking references individually where the rejections are based on combination of references. See *In re Keller*, 642 F. 2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F. 2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The examiner respectfully concludes that prima facie case of obviousness was made for independent claims 1 and 10 and thus, claims 1 and 10 are not ready for allowance.

In response to argument 'e', the examiner respectfully traverses. Since independent claims 1 and 10 are not allowable, the rest of dependent claims are also not ready for allowance.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to April Y. Shan whose telephone number is (571) 270-1014. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/April Y Shan/

Examiner, Art Unit 2135

/KIMYEN VU/

Supervisory Patent Examiner, Art Unit 2135